



BL O/219/05

2 August 2005

PATENTS ACT 1977

BETWEEN

Ernest Ogden

Claimant

and

John McKenzie and Projectile Limited

Defendants

PROCEEDINGS

Reference under sections 13 and 37 in
respect of patent number GB 2378382

HEARING OFFICER

D J Barford

PRELIMINARY DECISION

- 1 This decision is concerned with firstly whether this reference in respect of rights in patent number GB 2378382 (“the patent”) should be extended to cover rights in patent application number PCT/GB 2003/000293 (“the PCT application”); and secondly with a question as to what evidence should be admitted into these proceedings.

Background

- 2 Patent application number GB0119378.8 was filed on 9 August 2001 by Messrs Ogden and McKenzie and Projectile Limited naming Messrs Ogden and McKenzie as inventors and claiming no earlier priority. It was published on 12 February 2003 and granted on 19 November 2003 as GB 2378382.
- 3 The PCT application was filed on 17 January 2003, also by Messrs Ogden and McKenzie and Projectile Limited, naming Messrs Ogden and McKenzie as inventors and claiming no earlier priority.
- 4 These proceedings were launched on 1 December 2003 under sections 13 and 37. A statement was filed by Mr Ogden on that date followed by a supplementary statement on 18 December 2003. Two counterstatements were filed on 25 March 2004 by Mr McKenzie, one on his own behalf and the other on behalf of Projectile Limited. The usual evidence

rounds followed, with Mr Ogden filing evidence on 18 June 2004, Mr McKenzie filing evidence on 15 September 2004 and Mr Ogden filing evidence on 24 February 2005 and 19 April 2005. Some of this evidence was filed on earlier dates then re-submitted on the dates given, but that is not material to this decision.

- 5 There is a further application, number GB9828516.6 (“the earlier application”), referred to in both the statement and Mr McKenzie’s counterstatement. This was filed on 23 December 1998 by Mr Ogden naming himself as sole inventor and claiming no earlier priority. No request for preliminary examination and search being filed, this earlier application was terminated before publication.

The PCT application

- 6 There is no reference in either the statement or the supplementary statement to the PCT application. It is however referred to in Mr MacKenzie’s counterstatement in the following terms: “I have continued to progress the project and I am still incurring costs on the initial patent GB 2478382 and the additional Patent Application No PCT/GB 2003/000293”. It is also referred to in Projectile Limited’s counterstatement. Indeed this is headed “Reference: GB0119378.8/ GB2478382 and International Patent 2003/000293”. It includes the statement that “Projectile Limited .. claims a third ownership in Patent Number GB 2478382 and the International Patent 2003/000293”. In addition, Mr Ogden has referred to the PCT application in his evidence.
- 7 In view of the above, the Patent Office wrote to the parties on 30 September 2004 enquiring as to whether the PCT application was part of the present dispute. Mr Ogden responded that he wished it to be included. Mr McKenzie responded that its inclusion would “fundamentally alter” the dispute and that Mr Ogden should make a separate reference. The Patent Office followed this up by stating that inclusion of the PCT application would not appear to raise any additional matters to be considered at the substantive hearing, as the content of the patent and that of the PCT application appeared to be essentially the same, and requested detailed reasons from Mr McKenzie if he wished to resist its inclusion.
- 8 In a letter dated 28 November 2004 Mr McKenzie argued that the present proceedings do not in any way demonstrate any disagreement over the PCT, pointed out that, if anything, more work went into making the PCT application than the patent, and argued for the opportunity to file more evidence on the matter so that a judgement is not made without full knowledge of the facts.
- 9 Mr Ogden filed a detailed response in a letter dated 16 January 2005 including two copies of his earlier application, one annotated to show differences between patent application GB0119378.8 and the earlier application, and the other annotated to show differences between the PCT application and the earlier application; and arguing that the differences are negligible.
- 10 Mr McKenzie filed a detailed response in a letter dated 14 February 2005 including a copy of Mr Ogden’s earlier application annotated to show differences between the patent and the

earlier application. Mr McKenzie again points out in this letter the effort he had to put into filing the PCT application and states that he has had no input from Mr Ogden on this.

Findings on the PCT application

- 11 The rights in the PCT application may either be adjudicated on by extending the present reference or in the context of a second, separate reference. It seems to me that in deciding between these two alternatives, which is effectively the task before me, the most important factors that I need to take into account are cost, time and the extent to which - if a separate reference were filed - the comptroller would have to decide what is essentially the same issue in two separate proceedings.
- 12 Both Mr Ogden and Mr McKenzie have gone to a great deal of trouble to compare the text of the earlier application with that of patent application GB0119378.8 and the PCT application (Mr Ogden), and with that of the patent (Mr McKenzie). However the relevant comparison for the matter in issue is none of these; it is that between the patent and the PCT application - one the subject of this reference, the other a possible subject of this reference. On comparing these two documents, it seems to me that they are absolutely identical in wording.
- 13 Given this, I have to reject Mr McKenzie's argument that inclusion of the PCT application would "fundamentally alter" the dispute as ill founded. Equally I attach no weight to his argument that he has put a lot of effort into filing the PCT application unassisted by Mr Ogden. That may well be the case, but who put the effort into filing a patent application is a different matter from the key issue of who put the effort into actually devising the invention covered by the application.
- 14 It is clear that extending the present reference to include the PCT application is essential to avoid the need to adjudicate the same issue in two separate proceedings. Manifestly this will also save time and cost.
- 15 Accordingly I allow Mr Ogden's request to amend the reference to include the PCT application. It follows that as well as section 37, which relates to rights in UK patents, section 12 now comes into play. Section 12 relates to rights in, amongst other things, patent applications made under any treaty, and therefore covers rights in the PCT application.
- 16 For completeness I should add that I see no necessity for either party to file any further evidence as a result of this decision to include the PCT application.

The evidence

- 17 On 8 February 2005 Mr McKenzie stated that he wished to file further evidence going beyond that filed in the usual rounds, and argued that a system in which the claimant has the last word in the evidence rounds is unfair. In letters dated 25 February, 7 April and 17 April 2005 Mr McKenzie submitted further documents setting out in detail which parts of the evidence filed in the final round by Mr Ogden he regarded as not strictly in reply, and providing a response to

those parts of Mr Ogden's evidence.

- 18 Mr Ogden's initial response to this, in a letter dated 3 April 2005, was to argue that his evidence was strictly in reply and to object to the admission of Mr McKenzie's latest submissions. However in a letter dated 29 May 2005 Mr Ogden states that if this new evidence is allowed in it will give him (Mr Ogden) the opportunity to "clear up a couple of points". The points at issue are concerned with what was said in court at divorce proceedings between Mr and Mrs Ogden held on 28 July 2004 and 25 February 2005 concerning the length of time Mr McKenzie had known Mr Ogden and members of Mr Ogden's family. Mr Ogden wishes to file a witness statement from his solicitor on this particular matter.

Findings on evidence

- 19 Rules 8, 14 and 54 deal, amongst other things, with the filing of evidence in proceedings under sections 12, 13 and 37. Rules 8(5) to 8 (7) and rules 54(4) and (5) set out clearly and unambiguously the normal sequence of evidence rounds under sections 12 and 37 to which Mr McKenzie has raised objection - namely claimant's evidence, defendant's evidence and claimant's evidence strictly in reply. As to filing evidence further to these three rounds, rules 8(8) and 54(6) read identically as follows:

"No further evidence shall be filed by any party except by leave or direction of the comptroller".

Rule 14(4) which deals with matters under section 13 following filing of the statement and counterstatement is less prescriptive on the filing of evidence and simply states that:

"The comptroller may give such directions as he may think fit with regard to subsequent procedure".

- 20 It is clear from the above that whether I admit evidence beyond the normal three rounds is a matter for my discretion. Factors that I need to take into account are the reasons for the late submissions, the conduct of the parties in these proceedings, the potential impact on the hearing date, and the effect on the parties of admitting or refusing the evidence having regard to its relevance and importance. There is also the question of whether or not Mr Ogden's evidence was strictly in reply.
- 21 In deciding these questions I am very much aware of the fact that both Mr Ogden and Mr McKenzie are unrepresented in these proceedings; and both it seems to me have been doing their best to comply with complex and unfamiliar procedures. It is difficult at this stage of the proceedings to make a judgement as to the relevance and importance of the evidence in question, and since it is both parties that have requested the opportunity to put in further evidence my inclination is to admit it, that is to say to admit Mr Ogden's evidence in reply, to admit Mr McKenzie's further submissions and to allow Mr Ogden the limited opportunity to file the witness statement from his solicitor to which he has referred. I should make it clear to both parties however that any request to submit yet more evidence would have to be supported by compelling reasons. No date has been arranged for the substantive hearing, so

this proposal will not result in any loss of hearing date; and in fact steps can now be taken to arrange a date.

Conclusions and next steps

- 22 I have decided to allow Mr Ogden's request to amend the reference to include the PCT application, and to admit all of the evidence submitted to date by both parties.
- 23 In addition I allow Mr Ogden six weeks from the date of this decision to file the witness statement from his solicitor to which he has referred in his letter of 29 May 2005.

Costs

- 24 Neither party has asked for costs in respect of these preliminary matters and so I make no award.

Appeal

- 25 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

DAVID BARFORD

Deputy Director acting for the Comptroller